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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,226	12/19/2000	Shepherd Shi	AUS9-2000-0761-US1	4532

7590 03/31/2004
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EXAMINER

GODDARD, BRIAN D

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 03/31/2004

11

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/740,226

Applicant(s)

SHI ET AL.

Examiner

Brian Goddard

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. This communication is responsive to the Request for Reconsideration, filed 23 January 2004.
2. Claims 1-27 are pending in this application. Claims 1, 10 and 19 are independent claims. This action is made Final.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, claims 1-9 are directed to "a search method" which is nothing more than an algorithm or abstract idea, has no tangible or concrete embodiment, and produces no useful, tangible or concrete results.

To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 4, 6, 8-10, 13, 15, 17-19, 22, 24 and 26-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Traversat (U.S. 6,366,954).

Referring to claim 1, Traversat discloses a search method as claimed. See Figures 3-7 and the corresponding portions of Traversat's specification for this disclosure. In particular, Traversat teaches "a search method [See Figure 7] comprising the steps of:

determining [Step 706] if a first parameter [configuration request data (e.g. machine identifier, user name, user identifier)] has a first predetermined value [e.g. MAC Address – 511 or User Name – 601, 603, 605]; and

if said first parameter has said first predetermined value ['YES' branch from step 706 (706 → 710)], returning [Step 710] a value of each of one or more selected members [application specific configuration data 509 and/or 519] of a first node [501-507 and/or 515-517], said first node being referenced [See column 8, lines 43-64] by a value of a first member [513] of a second node [511] in response to said first member of said second node having a predetermined type [See column 8, lines 43-64]" as claimed.

Referring to claim 4, Traversat discloses the search method as claimed. See Figures 3-7 and the corresponding portions of the specification for this disclosure. Traversat teaches the method of claim 1, as above, "further comprising the step of

returning [Step 710] values of a selected set of members [513] of said second node [511]" as claimed.

Referring to claim 6, Traversat discloses the search method as claimed. See Figures 3-7 and the corresponding portions of the specification for this disclosure. Traversat teaches the method of claim 1, as above, "further comprising the step of...returning [Step 710] a value of each of one or more selected members [509 or 519] of a third node [501-507 or 515-517]...[See column 8, lines 43-64]" as claimed.

Referring to claim 8, Traversat discloses the search method as claimed. See Figure 7 and the corresponding portion of the specification for this disclosure. Traversat teaches the method of claim 1, as above, "wherein said first parameter [See above] comprises a parameter [e.g. machine identifier, user name, user identifier] of a set of parameters in a search request [704]" as claimed.

Referring to claim 9, Traversat discloses the search method as claimed. See Figure 7 and the corresponding portion of the specification for this disclosure. Traversat teaches the method of claim 8, as above, "wherein said search request [704] comprises a Lightweight Directory Access Protocol (LDAP) search request" as claimed.

Claims 10, 13, 15 and 17-18 are rejected on the same basis as claims 1, 4, 6 and 8-9 respectively. See the discussions regarding claims 1, 4, 6 and 8-9 above for the details of this disclosure.

Claims 19, 22, 24 and 26-27 are rejected on the same basis as claims 1, 4, 6 and 8-9 respectively. See the discussions regarding claims 1, 4, 6 and 8-9 above for the details of this disclosure.

5. Claims 1-27 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,587,874 to Golla et al.

Referring to claim 1, Golla teaches a search method as claimed. See Figures 1-4 and the corresponding portions of Golla's specification for this disclosure. In particular, Golla teaches "a search method [401] comprising the steps of:

determining [Step 403] if a first parameter [a parameter of an LDAP request principal (See column 3, lines 44-53; column 4, lines 35-60; and column 9, lines 36-46)] has a first predetermined value [particular DN attribute value (e.g. 'c=US')]; and

if said first parameter has a first predetermined value [if leaf node is identified], returning [Step 417] a value of each of one or more selected members [configuration parameters (e.g. 320)] of a first node [identified leaf node's parent (e.g. 314) {See Steps 409-413}], said first node being referenced by a value of a first member [particular DN attribute value] of a second node [identified leaf node (e.g. 304)] in response to said first member of said second node having a predetermined type [non-root]" as claimed.

Referring to claim 2, Golla discloses the search method as claimed. See Figures 1-4 and the corresponding portions of Golla's specification for this disclosure. Golla teaches the method of claim 1, as above, "further comprising the step of determining [Step 403] if a second member [another DN attribute value (e.g. 'o=Cisco Systems, Inc.')] of said second node [identified leaf node (e.g. 304)] matches a value of a second parameter [another parameter of the LDAP request principal]" as claimed.

Referring to claim 3, Golla discloses the search method as claimed. See Figures 1-4 and the corresponding portions of Golla's specification for this disclosure. Golla teaches the method of claim 2, as above, "wherein said step of returning [Step 417] said value of each of one or more members of said first node [See above] is in response to said second member of said second node matching said value of said second parameter [after the leaf node (e.g. 304) is found]" as claimed.

Referring to claim 4, Golla discloses the search method as claimed. See Figures 3-4 and the corresponding portions of Golla's specification for this disclosure. Golla teaches the method of claim 1, as above, "further comprising the step of returning [Step 417] values of a selected set of members [configuration parameters (e.g. 306)] of said second node [identified leaf node (e.g. 304)]" as claimed.

Claim 5 is rejected on the same basis as claim 3, in light of the basis for claim 4 above. Golla teaches the method of claim 4, as above, "further comprising the step of determining if a second member of said second node matches a value of a second parameter [See claim 2], and wherein said step of returning values of said selected set of members of said second node [See claim 4] is in response to said second member of said second node matching said value of said second parameter [See claim 3]" as claimed.

Referring to claim 6, Golla discloses the search method as claimed. See Figures 1-4 and the corresponding portions of Golla's specification for this disclosure. Golla teaches the method of claim 1, as above, "further comprising the step of, if said first parameter has said first predetermined value [See claim 1], returning [Step 417] a value

of each of one or more selected members [configuration parameters (e.g. 326)] of a third node [parent node of identified leaf node's parent (e.g. 324)], said third node being referenced by a value of a first member [particular DN attribute value] of said first node [identified leaf node's parent (e.g. 314)] in response to said first member of said first node having said predetermined type [non-root]" as claimed.

Claim 7 is rejected on the same basis as claim 2, in light of the basis for claim 6 above. Golla teaches the method of claim 6, as above, "wherein said selected members of said first node [See claim 1] and said selected members of said third node [See claim 6] are selected in response to a value of a second parameter [See claim 2]" as claimed.

Referring to claim 8, Golla discloses the search method as claimed. See Figures 1-4 and the corresponding portions of Golla's specification for this disclosure. Golla teaches the method of claim 1, as above, "wherein said first parameter [See claim 1] comprises a parameter of a set of parameters [principal] in a search request [LDAP request (See step 403)]" as claimed.

Referring to claim 9, Golla discloses the search method as claimed. See Figures 1-4 and the corresponding portions of the specification for this disclosure. Golla teaches the method of claim 8, as above, "wherein said search request comprises a Lightweight Directory Access Protocol (LDAP) search request" as claimed. See column 3, lines 44-53; column 4, lines 35-60; and column 9, lines 36-46 for the details of this disclosure.

Claims 10-18 are rejected on the same basis as claims 1-9 respectively. See the discussions regarding claims 1-9 above for the details of this disclosure.

Claims 19-27 are rejected on the same basis as claims 1-9 respectively. See the discussions regarding claims 1-9 above for the details of this disclosure.

Response to Arguments

6. Applicant's arguments filed 23 January 2004 have been fully considered but they are not persuasive.

Referring to applicants' remarks on pages 2-5 regarding the Section 101 rejection of claims 1-18: Applicants' argued that the claimed method (Claims 1-9) produces a useful, concrete and tangible result in a return value for one or more selected members of a node in response to a search, while the claimed computer program product (Claims 10-18) is statutory subject matter because of the nature of a computer program product in a tangible storage medium.

The examiner agrees that claims 10-18 constitute statutory subject matter. Applicants' arguments with regard to the Section 101 rejection of these claims are considered persuasive. Therefore, the rejection has been withdrawn.

However, the examiner disagrees with applicants' arguments with regard to claims 1-9. Namely, a return value is not considered a concrete and tangible result because there is no explicit or implicit concreteness or tangibility of the return value in the claims. For example, the 'return value' is not displayed on a display screen or printed on paper. It is noted that applicants' have not provided any evidence or

reasoning as to how a 'return value' is concrete and tangible. The Office finds no reason to believe that a "value" can be considered concrete and tangible. In fact, there is nothing concrete or tangible about claims 1-9 at all. Accordingly, the Section 101 rejection of these claims is maintained.

Referring to applicants' remarks on pages 5-8 regarding the Section 102 rejection of the independent claims over Traversat: Applicants argued that Traversat does not teach the claimed steps of determining if a first parameter has a first predetermined value and returning a value of each of one or more selected members of a first node, and further that the problem addressed by Traversat and the instant application are completely different.

The examiner disagrees for the following reasons: Applicants have reduced Traversat's disclosure of step 706 to a mere determination if data is available from the JSD server. However, applicants have completely ignored the details of this step. Specifically, in order to determine if the requested data is available in the JSD server, the parameter(s) of the request must be matched against the predetermined values of these parameter(s) in the server. Thus, to determine if the requested data is available in the JSD server is to determine if a first parameter [a parameter of the request] has a first predetermined value [a value matching values available in the server] as claimed. Not only is this fully disclosed in the Figures and Claims (See e.g. claims 19 & 21) of Traversat's disclosure, but it is inherent to any kind of searching (such as that of Traversat) because a parameter of a search request must be matched with

predetermined values in the object(s) being searched. Therefore, Traversat does teach the claimed step of determining if a first parameter has a first predetermined value.

Applicants' assertions that there is no disclosure of a methodology in conjunction with Figure 5 (of Traversat) and there is nothing being returned in conjunction with Figure 5 are completely unfounded in Traversat's disclosure. In introducing the disclosure of Figure 7, Traversat explicitly states that the method of Figure 7 is directed towards the use of the configuration server and configuration data formats as shown and discussed in Figures 3-6. See column 9, lines 23-29 for the details of this disclosure. Thus, the methodology of Figure 7, wherein the value of each of one or more selected members of a first node are returned in Step 710 is directed explicitly at the data formatted as in Figure 5. Therefore, Traversat does teach the claimed step of returning a value of each of one or more selected members of a first node, contrary to applicants' assertions. It is noted that applicants' arguments constitute a piecemeal analysis of the reference, wherein applicants completely ignore the details of Traversat's disclosure as a whole.

In response to applicant's argument that Traversat is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Traversat is both in the field of applicants' endeavor and pertinent to the problem which applicant was concerned.

Referring to applicants' remarks on pages 8-11 regarding the Section 102 rejection of some of the dependent claims over Traversat: Applicants argued substantially the same points as those directed towards the independent claims.

The examiner disagrees for substantially the same reasons as discussed above in regard to the independent claims.

Referring to applicants' remarks on pages 11-13 regarding the Section 102 rejection of the independent claims over Golla: Applicants argued that Golla does not teach the claimed steps of determining if a first parameter has a first predetermined value and returning a value of each of one or more selected members of a first node.

The examiner disagrees for the following reasons: Applicants have reduced the reliance on Golla's disclosure of Step 403 to a determination as to whether the principal, or DN for the leaf node is itself. However, this is not the case. Applicants have again ignored the details of the disclosure. Golla's step 403 identifies the leaf node in the server that matches the parameters in the request. This is another searching process wherein the parameters of the request are matched with the data in the data structures stored in the server, the nodes of the LDAP hierarchy, as the hierarchy is traversed. Thus, the leaf node is identified in step 403 by searching the hierarchy for the leaf node who's predetermined value(s) match the parameter(s) of the request. Accordingly, Golla does teach the claimed step of determining if a first parameter [a parameter of the request] has a first predetermined value [a value matching that in a leaf node on the server]. Not only is this explicitly disclosed in Figures 1-4 and the corresponding portions of Golla's specification as cited above, but it is inherent to any kind of

searching. See the discussion regarding the same limitation in comparison to Traversat's disclosure above.

Applicants' assertion that there is no teaching in Golla in which a first node is referenced by a value of a first member of a second node is completely unfounded in Golla's disclosure. Applicants have misconstrued the grounds of rejection provided, and wholly ignored the details of Golla's disclosure as cited. Contrary to applicants' statements, the Examiner did not identify the value of the first member referencing the first node as the particular DN. The value of the first member referencing the first node was identified as **an attribute value of the particular DN**, not the entire DN. As clearly shown and described in Golla's specification, a whole DN is composed of smaller attributes (or names) such as "c=US" and "o=Cisco Systems, Inc." for example. Each node in the hierarchy references its parent(s) through one or more of these attribute(s), as shown and disclosed in Figures 1B & 3 and the corresponding portions of Golla's specification.

Applicants' assertion that there is no decisional step with respect to identification of a leaf node in Golla is also completely unfounded in Golla's disclosure. In identifying the leaf node, the hierarchy is traversed by deciding at each node whether the attributes of the request match the attributes of the node and if so, then the leaf node is identified as proper while if not, the traversal/search continues. Again, see Figures 1-4 of Golla's specification for this disclosure. Therefore, Golla does teach the claimed step of returning a value of each of one or more selected members of a first node.

Referring to applicants' remarks on pages 13-17 regarding the Section 102 rejection of the dependent claims over Golla: Applicants argued substantially the same points as those directed towards the independent claims.

The examiner disagrees for substantially the same reasons as discussed above in regard to the independent claims.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goddard whose telephone number is 703-305-7821. The examiner can normally be reached on M-F, 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bdg
29 March 2004



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